

REMARKS

Applicant submits these Remarks in reply to the Office Action mailed on November 29, 2007. Claim 88 has been cancelled by this Amendment without prejudice or disclaimer. Thus, claims 46-79 and 83-87 remain pending in this application, of which claim 84 is the sole independent claim.

In the Office Action, the Examiner objected to claims 51 and 64 due to informalities; rejected claims 46-62, 73, 75-79, and 83-85 under 35 U.S.C. § 103(a) as being unpatentable over an IEEE Publication ("Meurer") in view of WO 98/52197 ("Belli '197"); rejected claims 62, 63, 69-72, and 84 under § 103(a) as being unpatentable over Meurer in view of WO 99/33070 ("Belli '070"); and rejected claims 64-68, 74, 84, and 86-88 under § 103(a) as being unpatentable over Meurer in view of U.S. Pat. Pub. No. 2005/0046073 ("Balconi").

In this Reply, Applicant has amended independent claim 84 to recite, among other things:

determining a correlation between a thickness of said protective element and a thickness of said insulating layer so as to ensure the safe operation of the cable in the selected voltage class on said selected conductor cross-sectional area and that the cable is not detectably damaged upon an impact on the cable by an energy of at least 25 J

Support for this amendment can be found in Applicant's specification at least at page 6, lines 10-31, page 7, lines 6-15, and page 24, lines 10-18.

Applicant respectfully traverses all pending rejections for at least the reasons discussed below.

Examiner's Objections Based on Informalities

In the Office Action, the Examiner objected to claim 51, asserting the word "said" should precede the word "IEC," and objected to claim 64, stating the word "cable" should be changed to the word "method."

Applicant notes that due to the amendment of independent claim 84, the Examiner's concern regarding claim 51 is moot as this is now the first and only mention of the term "IEC Standard 60502-2 (Ed. 1.1–1998-11)." Regarding claim 64, Applicant has made the requested amendment.

Accordingly, Applicant requests the Examiner reconsider and withdraw the objections to claims 51 and 64 based on informalities.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 46-62, 73, 75-79, and 83-85 under 35 U.S.C. § 103(a) as being unpatentable over Meurer in view of Belli '197; rejected claims 62, 63, 69-72, and 84 under § 103(a) as being unpatentable over Meurer in view of Belli '070; and rejected claims 64-68, 74, 84, and 86-88 under § 103(a) as being unpatentable over Meurer in view of Balconi. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, neither Meurer, Belli '197, Belli '070, Balconi, nor their combination, teach or suggest every feature of Applicant's claims. Specifically, none of the references cited by the Examiner, nor their combination, teach or suggest the method recited in independent amended claim 84, namely the step of "determining a correlation between a thickness of said protective element and a thickness of said insulating layer so as to ensure the safe operation of the cable in the selected voltage class on said selected conductor cross-sectional area and that the cable is not detectably damaged upon an impact on the cable by an energy of at least 25 J."

In the Office Action, the Examiner acknowledged that Meurer does not teach even the presence of a "protective element including at least one polymeric expanded layer." Office Action at 4. Meurer may, in fact, disclose the presence of an insulating layer of reduced thickness, but the reference does not address the effects of damage which can occur to the cable due to accidental impacts taking place during the transportation or installation of the cable. Thus, Meurer discusses only a cable when it is in its original geometric conditions, i.e. when ideal conditions are present. In other words, this reference does not take into consideration the case in which an impact can occur on the cable, thereby reducing the insulation thickness and causing an increase of the cable electrical voltage stress (electrical gradient). This aspect is very relevant since, in the presence of a reduced insulation thickness and in the absence of a specific solution to suitably protect the cable from impacts, an impact can considerably reduce the already reduced insulation thickness and cause the failure of the cable or, at least,

ensure that the electrical stress conditions for that specific cable category are satisfactorily withstood.

Further, while the other references cited by the Examiner may disclose a cable comprising a protective element, none of those references appears to disclose determining a correlation between the thickness of that protective element and the thickness of the insulating layer. As a result, the references as combined by the Examiner in the Office Action fail to teach or suggest the step of “determining a correlation between a thickness of said protective element and a thickness of said insulating layer” so as to ensure the safe operation of the cable in the selected voltage class on said selected conductor cross-sectional area and the cable is not detectably damaged upon an impact on the cable by an energy of at least 25 J.”

Accordingly, Applicant respectfully requests the Examiner reconsider and withdraw the rejection of independent claim 84 under 35 U.S.C. § 103(a) as being unpatentable over Meurer in view of either Belli '197, Belli '070, or Balconi.

Moreover, claims 46-79, 83, and 85-87 depend from independent claim 84 and, thus, contain all the elements and recitations thereof. As a result, dependent claims 46-79, 83, and 85-87 are allowable at least due to their corresponding dependence from independent claim 84.

Claim Scope

It is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and or shown in the drawings. Rather, Applicant believes that he is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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By: _____

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